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DOCKET NO. HRT-281

OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: S. Boyd et al.

Serial No.: 09/982,503

Art Unit: 3738

Filed : October 18, 2001

Examiner: D. Isabella

For : DEVICES AND METHODS FOR PORT-ACCESS MULTIVESSEL  
CORONARY ARTERY BYPASS SURGERY

I hereby certify that this correspondence is being deposited with the  
United States Postal Service as first class mail in an envelope addressed  
to: Commissioner of Patents, P.O. Box 1450, Alexandria VA 22313-1450 on

January 12, 2004  
(Date of Deposit)

Brian S. Tomko  
(Name of applicant, assignee, or Registered Representative)

*BST*  
(Signature)

January 12, 2004  
(Date of Signature)

Honorable Commissioner of Patents  
Mail Stop Petition  
Alexandria, VA 22313

**PETITION TO ACCEPT**  
**AN UNINTENTIONALLY DELAYED CLAIM OF PRIORITY**

Dear Sir:

This Petition is made in response to the Office Action dated September 11, 2003, wherein the Examiner rejected all of the pending claims as anticipated by a patent related to the pending application. A copy of the Office Action is attached as Appendix A.

Applicants hereby petition the Commissioner under 37 C.F.R. §1.78(a)(3) to claim the benefit under 35 U.S.C. § 120 of earlier filed applications in the United States. This claim has not been previously filed in connection with this application. The correct claim of priority is described below.

01/16/2004 AWONDAF1 00000025 100750 09982503

01 FC:1454 1330.00 DA

This application is a divisional of U.S. Patent Application Serial No. 09/487,024, filed January 19, 2000, now issued as U.S. Patent No. 6,494,211, which is a continuation of U.S. Patent Application Serial No. 09/019,014, filed February 5, 1998 now abandoned, which is a division of U.S. Patent Application Serial No. 08/486,941, filed June 7, 1995, now U.S. Patent No. 5,799,661, which is a continuation-in-part of U.S. Patent Application Serial No. 08/281,891, filed July 28, 1994, now U.S. Patent No. 5,735,290, which itself is a continuation-in-part of copending U.S. Patent Application Serial No. 08/023,778, filed February 22, 1993 now U.S. Patent No. 5,452,733.

The entire delay between the date the priority claim was due under paragraph §1.78(a)(2)(ii), four months from the actual filing date of this application (October 18, 2001), and the date the priority claim was made (January 12, 2004, the date on which this Petition is mailed), was unintentional. When the current application was filed, priority was claimed to the prior pending application (Serial No. 09/487,024, filed on January 19, 2000), as is shown in box 18 of the Transmittal Sheet dated October 18, 2001, attached as Appendix B. The first page of the specification of the filed application included a related applications paragraph (attached as Appendix C), which listed a claim to priority to the two earliest related applications in the chain listed above (Serial No. 08/281,891, filed on July 28, 1994, and Serial No. 08/023,778, filed on February 22, 1993). The Preliminary Amendment filed on October 18, 2001, failed to amend the related applications paragraph to include the related applications filed between the parent application and the two earliest related applications.

Applicants's undersigned representative first became aware of the need to update the priority statement when preparing to respond to the outstanding Office Action (Appendix A). Upon reviewing the pending Office Action on December 10, 2003, the undersigned became aware of the need to petition to claim priority and promptly filed this Petition within one month.

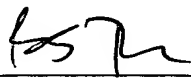
Please charge the surcharge set forth in 37 CFR § 1.17(t) of \$1,330.00 to Account 10-0750/HRT-281/BST and any additional surcharge or fee that is required in connection with this petition.

Serial No. 09/982,547

HRT 0281

Please feel free to contact me, if anything further is required at (732)524-1239.

Respectfully submitted,

By:   
\_\_\_\_\_  
Brian S. Tomko  
Reg. No. 41,349

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-1239  
(732) 524-5575 (fax)  
Dated: January 12, 2004



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,503	10/19/2001	Stephen W. Boyd	HRT-0281	8002

27777 7590 09/11/2003

AUDLEY A. CIAMPORCERO JR.  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

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SEP 15 2003

EXAMINER

ISABELLA, DAVID J

ART UNIT PAPER NUMBER

3738

J&J PAT. DKT. SECTION

DATE MAILED: 09/11/2003

*Response Due 12/11/03*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/982,503

Applicant(s)

BOYD ET AL.

Examiner

DAVID J ISABELLA

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 55-95 and 106-143 is/are pending in the application.
- 4a) Of the above claim(s) 109-120 and 130-143 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 106-108 and 121-129 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 3738

***Election/Restrictions***

Claims 109-120, 130-143 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9/2/15  
Claims 106-108, 121, 126, 127, 128 and 129 are rejected under <sup>not prior art</sup> 35 U.S.C. 102(b) as being anticipated by any of Laghi (5117822), Benetti, et al (5894843) or Borst et al <sup>not prior art</sup> (5836121). A device including a shaft having proximal and distal ends, contact surface and means for applying a vacuum at the contact surface is disclosed by Laghi, Benetti et al and Borst et al.

Claim 107, each of Laghi, Benetti et al and Borst et al disclose passage in fluid communication with the contact surface.

Claim 108, the contact surface comprises a friction increasing surface.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 106-108, 121-129 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyd et al(5799661)


The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Art Unit: 3738

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



DAVID J ISABELLA  
Primary Examiner  
Art Unit 3738

dji



**Notice of References Cited**

Application/Control No.

09/982,503

Applicant(s)/Patent Under  
Reexamination  
BOYD ET AL.

Examiner

DAVID J ISABELLA

Art Unit

3738

Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,034,006	07-1991	Hosoda et al.	604/317
	B	US-5,799,661	09-1998	Boyd et al.	128/898
	C	US-5,117,822	06-1992	Laghi, Aldo A.	607/105
	D	US-5,891,017	04-1999	Swindle et al.	600/205
	E	US-5,836,311	11-1998	Borst et al.	128/897
	F	US-5,894,843	04-1999	Benetti et al.	128/898
	G	US-5,727,569	03-1998	Benetti et al.	128/898
	H	US-5,484,391	01-1996	Buckman et al.	601/135
	I	US-6,478,029	11-2002	Boyd et al.	128/898
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

**REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED**  
**COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003**

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

***Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.***

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

**REVISED AMENDMENT PRACTICE**

**I. Begin each section of an amendment document on a separate sheet:**

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

**II. Two versions of amended part(s) no longer required:**

37 CFR 1.121 has been revised to no longer require two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for substitute specifications under 37 CFR 1.125 have been retained.

**A) Amendments to the claims:**

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and **the text of each pending claim** (with markings to show current changes) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), ***(previously presented) and (not entered)***. The text of all pending claims, ***including withdrawn claims***, must be submitted each time any claim is amended. Canceled ***and not entered*** claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims being currently amended must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for ***deletion of five characters or fewer, double brackets may be used (e.g., [1error])***; and (2) if ***strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [14])***. ***As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., ~~number 1 as number 14 as~~)***. An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims not being currently amended, ***including withdrawn claims***, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

Please type a plus sign (+) inside this box ☐

APPENDIX B

# UTILITY PATENT APPLICATION TRANSMITTAL

(only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.

HRT-281

First Inventor

Stephen W. Boyd et al.

Title

Devices and Methods for Port-Access Multivessel Coronary Artery Bypass Surgery

Express Mail Label No.

EL691443634 US

## APPLICATION ELEMENTS

See MPEP Chapter 600 concerning utility patent application contents.

ADDRESS TO: Commissioner for Patents  
Box Patent Application  
Washington, DC 20231

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)  
(submit an original and a duplicate for fee processing)
2. ☐ Applicant claims small entity status.
3. ☒ Specification [Total Pages 64]  
(Preferred arrangement set forth below)
  - Descriptive Title of the Invention
  - Cross Reference to Related Applications
  - Statement Regarding Fed sponsored R&D
  - Reference to sequence listing, a table, or a computer program listing appendix
  - Background of the Invention
  - Brief Summary of the Invention
  - Brief Description of the Drawings (if filed)
  - Detailed Description
  - Claim(s)
  - Abstract of the Disclosure
4. ☒ Drawing(s) (35 USC 113) [Total Sheets 36]
5. Oath or Declaration [Total Pages 5]
  - a. ☐ Newly executed (original or copy)
  - b. ☒ Copy from a prior application (37 CFR 1.63(d))  
(for continuation/divisional with Box 18 completed)
    - i. ☐ **DELETION OF INVENTOR(S)**  
Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76

7. ☐ CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)

8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)

- a. ☐ Computer Readable Form (CRF)
- b. ☐ Specification Sequence Listing on:
  - i. ☐ CD-ROM or CD-R (2 copies); or
  - ii. ☐ paper
- c. ☐ Statement verifying identity of above copies

## ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement ☐ Power of Attorney  
(when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503)  
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s)  
(if foreign priority is claimed)
16. ☐ Request and Certifications under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
17. ☐ Other

18. ☒ If a CONTINUING APPLICATION, check appropriate box and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☒ Divisional ☐ Continuation-in-Part (CIP) of prior application No.: 09/487,024, filed 01/19/00.

Prior application information: Examiner D. Isabella Group Art Unit: 3738

For CONTINUATION or DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

## 19. CORRESPONDENCE ADDRESS

☒ Customer Number or Bar Code Label 000027777 or ☐ Correspondence Address below

Name: Philip S. Johnson, Esq.

Address: Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003 USA

## 20. TELEPHONE CONTACT

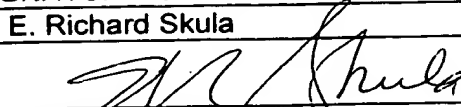
Please direct all telephone calls or telefaxes to E. Richard Skula at:

Telephone: (732) 524-2718 Fax: (732) 524-2808

## 21. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

NAME E. Richard Skula Reg. No. 31061

SIGNATURE



DATE

October 18, 2001

EL691443634US

DEVICES AND METHODS FOR PORT-ACCESS MULTIVESSEL  
CORONARY ARTERY BYPASS SURGERY

This application is a continuation-in-part of copending U.S. patent application  
5 Serial No. 08/281,891, filed July 28, 1994, which itself is a continuation-in-part of  
copending U.S. patent application Serial No. 08/023,778, filed February 22, 1993. The  
complete disclosures of these related U.S. patent applications are hereby incorporated  
herein by reference for all purposes.

10 FIELD OF THE INVENTION

The present invention relates generally to devices and methods for performing  
thoroscopic cardiac procedures. More particularly, the present invention relates to  
devices and methods for performing coronary artery bypass graft (CABG) surgery for  
multivessel coronary artery disease through port-access or closed-chest thoroscopic  
15 methods.

BACKGROUND OF THE INVENTION

Coronary artery disease remains the leading cause of morbidity and mortality in  
Western societies. Coronary artery disease is manifested in a number of ways. For  
20 example, disease of the coronary arteries can lead to insufficient blood flow resulting in  
the discomfort and risks of angina and ischemia. In severe cases, acute blockage of  
coronary blood flow can result in myocardial infarction, leading to immediate death or  
damage to the myocardial tissue.

A number of approaches have been developed for treating coronary artery disease.  
25 In less severe cases, it is often sufficient to treat the symptoms with pharmaceuticals and  
lifestyle modification to lessen the underlying causes of disease. In more severe cases, the